# UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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*Ex parte* SHIMON SHMUELI,
ALEX LANG, and JEAN BILLMAN

_____

Appeal 2008-3919
Application 09/802,634
Technology Center 3600

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Decided: March 30, 2009

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*Before* MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
DAVID B. WALKER, *Administrative Patent Judges.*

LORIN, *Administrative Patent Judge.*

An oral hearing was held on Mar. 17, 2009.

DECISION ON APPEAL

STATEMENT OF THE CASE

Shimon Shmueli, et al. (Appellants) seek our review under 35 U.S.C.
§ 134 of the Final Rejection of claims 1-7, 9-19, and 21-27. Claims 8, 20,
and 28 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b)
(2002).

The Board reversed a prior rejection of claims 1-7, 9-19, and 21-27. (Appeal 2006-0989; decided Mar. 28, 2006). The present appeal concerns rejections over newly cited prior art.

## SUMMARY OF DECISION

We REVERSE.[1]

## THE INVENTION

The claimed invention is directed to a portable device (claim 1), a computer readable medium including software to reside on the portable device (claim 13), and a method for facilitating a web-based transaction using the portable device (claim 21).

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

> 1. A portable device comprising:
> a) a body;
> b) memory within the body containing software and financial account information;
> c) an interface associated with the memory and adapted to facilitate interaction with the host computing device during a computing session;
> d) the software adapted to execute on the host computing device to instruct the host computing device to:
> i) recognize financial account fields in a web page during a browsing session;

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[1] Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Jul. 18, 2007) and Reply Brief ("Reply Br.," filed Dec. 04, 2007), and the Examiner's Answer ("Answer," mailed Oct. 4, 2007).

     ii) fill in the financial account fields in the
web page with the financial account information
from the portable device to facilitate a web-based
transaction;
     iii) automatically execute on the host
computing device in association with the
computing session; and
     iv) in association with termination of the
computing session, instruct the host
computing device to remove records pertaining to
the computing session from the host
computing device to enhance privacy associated
with the computing session.

## THE REJECTIONS

The Examiner relies upon the following as evidence of

unpatentability:

| | | |
|---|---|---|
| Pitroda | US 5,884,271 | Mar. 16, 1999 |
| Inala | US 6,199,077 B1 | Mar. 6, 2001 |
| Davis | US 2002/0029254 A1 | Mar. 7, 2002 |
| Turgeon | US 2003/0014371 A1 | Jan. 16, 2003 |
| Arnold | US 6,950,857 B1 | Sep. 27, 2005 |

The Examiner took Official Notice that "automatically executing a
remote device on a host device is old and well known in the art." Answer 4
and 7.

The following rejections are before us for review:

1. Claims 1-3, 6, 7, 9-15, 18, 19, 21-23, 26, and 27 are rejected under

  35 U.S.C. § 103(a) as being unpatentable over Pitroda, Arnold,

  Turgeon, and Official Notice.

2. Claims 4, 5, 16, 17, 24, and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pitroda, Turgeon, Inala, and Official Notice.[2]

3. Claims 1-7, 9-19, and 21-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Davis, Arnold, Turgeon, and Official Notice.

ARGUMENTS

The Examiner took the position that Pitroda and Davis disclose the subject matter claimed in independent claim 1 and all its limitations except that they do not specifically mention (a) financial fields of a web page are recognized and filled in during the web based transaction (Answer 4 and 7); (b) auto execution on the PC (Answer 4 and 7), and, (c) "residual data is flushed from the host PC" (Answer 5 and 7). To show these three limitations were known in the art, the Examiner relied on Arnold, Official Notice that automatically executing a remote device on a host device is old and well known in the art, and Turgeon, respectively. The Examiner found that, given Pitroda or Davis, and Arnold, Turgeon, and Official Notice, one of ordinary skill in the art would have been led to the claimed invention. Accordingly, the Examiner found the subject matter of claim 1 obvious over the prior art. The Examiner took the same position with respect to the subject matter of the other independent claims 13 and 21 to the computer readable medium and method, respectively. See Answer 6 and 9.

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[2] Given that claims 4 and 5, 16 and 17, and 24 and 25 depend from claims 1, 13, and 21, respectively, Arnold, which was applied against claims 1, 13 and 21, should have been included as a reference in the statement of the rejection of these claims.

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The Appellants argued that the Examiner has not shown software on a portable device instructing the host computer to perform steps d) i)-iv) as claimed. Regarding Pitroda, the Appellants argued that "the software disclosed in Pitroda is just for reading information from [a UET] card; there is no mention of the software instructing the host computer to do anything." App. Br. 7. Regarding Davis, the Appellants argued that "there is no indication in Davis that the applications on the smart card device adapted to execute on the host computing device to instruct the host computing device, as required by the claimed invention." App. Br. 23. Regarding Arnold, the Appellants argued that Arnold discloses a robot program for populating fields of a web clipping representing a web page but it "is not software that executes on the computing device" (App. Br. 16) and the program resides in a data center and thus "does not disclose filling in the financial account fields with financial account information from a portable device" (App. Br. 17). Regarding Turgeon, the Appellants agreed that Turgeon discloses "a memory in the PC is flushed to erase data" (App. Br. 8) but the Appellants argued that "in Turgeon, it is not the software provided by the portable device that instructs the host computing device to remove records pertaining to the computing device. ... [I]n Turgeon, after the flushing of memory is done, the Web host server continues the transaction ... ." App. Br. 8. Accordingly, the Appellants take the position that the Examiner has not made out a prima facie case of obviousness.

The Examiner disagreed with the Appellants' argument. With respect to the rejection involving Pitroda, the Examiner pointed to col. 10, ll. 40-50 (Answer 4) and col. 11, ll. 58-67 and col. 12, ll. 33-36 (Answer 10) as teaching software on a portable device instructing a host computer. With

respect to the rejection involving Davis, the Examiner relied on the passages at [0036], [0043], and [0059] of Davis. Answer 6-7.

## ISSUE OF LAW

Has the Examiner shown software on a portable device instructing the host computer to perform steps d) i)-iv) as claimed and thereby established a prima facie case of obviousness?

## PRINCIPLE OF LAW

*Obviousness*

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.") The Court in *Graham* further noted that evidence of secondary considerations "might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." 383 U.S. at 17-18.

## ANALYSIS

*The rejection of claims 1-3, 6, 7, 9-15, 18, 19, 21-23, 26, and 27 under
35 U.S.C. § 103(a) over Pitroda, Arnold, Turgeon, and Official Notice.*

The Examiner pointed to col. 10, ll. 40-50 (Answer 4) and col. 11, ll.
58-67 and col. 12, ll. 33-36 (Answer 10) of Pitroda as teaching software on a
portable device instructing a host computer. We have reviewed the
indicated passages and find no such disclosure. Col. 10, ll. 40-50 of Pitroda
discloses software to provide an interface between the home PC and the
UET [universal electronic transaction card], but says nothing about where
that software resides. Col. 11, ll. 58-67 describes software block on the UET
card and lists various types of information which the blocks may include.
Col. 12, ll. 33-36 indicates that the UET may include modules, drivers, and
other management software. The passages the Examiner relied upon do not
support the Examiner's position. We agree with the Appellants that Pitroda
does not disclose software on the portable device for instructing the host
computer to do anything, let alone the steps claimed. Because the cited prior
art does not support the Examiner's position that it shows all the limitations
claimed, we further agree with the Appellants that the Examiner has not
presented a prima facie case of obviousness. The rejection is reversed.


*The rejection of claims 4, 5, 16, 17, 24, and 25 under 35 U.S.C. § 103(a)
over Pitroda, Turgeon, Inala, and Official Notice.*

The claims involved in this rejection depend from claims whose
rejection we have reversed above. We will not sustain the rejection of these
claims over the cited prior art for the reasons stated. Inala does not remedy
the deficiencies discussed previously with respect to Pitroda.

*The rejection of claims 1-7, 9-19, and 21-27 under 35 U.S.C. § 103(a) over
Davis, Arnold, Turgeon, and Official Notice.*

The Examiner pointed to [0036], [0043], and [0059] of Davis (Answer
6-7) as suggesting software residing on a portable device with capability to
instruct a host computer. We have reviewed the indicated passages and find
no such suggestion. [0036] describes applications residing on the smart card
which may give the card "server-like functionality." [0043] describes a data
management component for managing user data residing on the smart card.
[0059] describes a financial application configured to store financial data
which user can import to an e-commerce website. We see nothing in these
disclosures about software on the portable device for instructing the host
computer to do anything, let alone the steps claimed.

We note that the Examiner also argued "it is inherent that a [sic, an]
application that is operated on a secondary device such as when a smart card
executes on a PC, must use the PC to execute the application in order to
have the PC function." Answer 13. However, the question is whether the
prior art shows software on a portable device instructing the host computer
to perform the tasks claimed. Whether or not an application on a portable
device would necessarily execute on a PC does not sufficiently address the
limitations in the claims requiring the software on the portable device to
instruct the host computer to perform the specific tasks claimed. Here Davis
does not show an application on a portable device capable of instructing a
host computer to perform the tasks set forth in the claims. To argue that
Davis shows a financial application on a portable device and then argue that
it is inherent that such an application would execute on a host computer not
only neglects to address the specific tasks set forth in the claims but reflects

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an attempt to use hindsight reconstruction to supply deficiencies in the factual basis for the rejection. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the Appellants' disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. *See, e.g., Grain Processing Corp. v. American Maize-Products Co.,* 840 F.2d 902, 907 (Fed. Cir. 1988). "Obviousness can not be established by hindsight combination to produce the claimed invention," *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998).

## CONCLUSIONS OF LAW

We conclude that the Appellants have shown that the Examiner erred in rejecting claims 1-3, 6, 7, 9-15, 18, 19, 21-23, 26, and 27 under 35 U.S.C. § 103(a) as being unpatentable over Pitroda, Arnold, Turgeon, and Official Notice; claims 4, 5, 16, 17, 24, and 25 under 35 U.S.C. § 103(a) as being unpatentable over Pitroda, Turgeon, Inala, and Official Notice; and, claims 1-7, 9-19, and 21-27 under 35 U.S.C. § 103(a) as being unpatentable over Davis, Arnold, Turgeon, and Official Notice.

## DECISION

The decision of the Examiner to reject claims 1-7, 9-19, and 21-27 is reversed.

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REVERSED

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JRG


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